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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,791	02/25/2004	Zhaoda Zhang	13498-010003	9031
26191	7590	09/13/2006		
FISH & RICHARDSON P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				
			EXAMINER JONES, DAMERON LEVEST	
			ART UNIT 1618	PAPER NUMBER

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/786,791	Applicant(s) ZHANG ET AL.	
	Examiner D. L. Jones	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2006.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,14,16,17,19,21,22 and 65 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 11,14,16,17,19,21,22 and 65 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>6/13/06</u> . | 6) <input type="checkbox"/> Other: _____ |

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the amendment filed 6/13/06 wherein claims 1-10, 12, 13, 15, 18, 20, 23-64, and 66-77 are canceled and claims 11, 14, 16, 17, 19, 21, and 65 are amended.

Note: Claims 11, 14, 16, 17, 19, 21, 22, and 65 are pending.

RESPONSE TO APPLICANT'S ARGUMENTS/AMENDMENT

2. Applicant's arguments filed 6/13/06 have been considered and are deemed persuasive because Applicant has either amended the claims to overcome the cited rejection or canceled the claim(s) of interest. However, the new grounds of rejection are deemed necessary because Applicant has incorporated some of the same limitations into the pending claims for which 112, second paragraph, rejections existed for previously pending claims.

Obviousness-type Double Patenting Rejection

The obviousness-type double patenting rejection is WITHDRAWN for reasons of record in Applicant's response filed 6/13/06.

Statutory Double Patenting Rejection

The statutory double patenting rejection is WITHDRAWN for reasons of record in Applicant's response filed 6/13/06.

112 Second Paragraph Rejections

The 112, second paragraph, rejections are WITHDRAWN because Applicant has canceled the appropriate claims.

NEW GROUNDS OF REJECTIONS (112 Second Paragraph Rejections)

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11, 14, 16, 17, 19, 21, 22, and 65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11, 14, 16, 17, 19, 21, 22, and 65: The claims as written are ambiguous because they contain various terms which are vague and indefinite for one or more of the following reasons: (1) the claims are ambiguous because it is unclear what 'carboxylate precursor group' (see claim 11, lines 12-15 and 17; claim 14, lines 12-15 and 17) Applicant is claiming to be compatible with the instant invention. See also claim 17, line 12. (2) Claim 16, lines 11-12: the claim is ambiguous because it is unclear what species are compatible with the instant invention that are encompassed by the phrase 'precursor chelate moiety'. (3) Claim 16, lines 12 and 13: the claim as written is ambiguous because of the phrases 'carboxylate precursor groups' and 'precursor chelate moiety' because it is unclear what species Applicant is claiming that are compatible with the instant invention. See also claim 17, lines 11-13; claim 19, lines 11-13; and claim 65, lines 9-12. (4) Claims 11 (lines 25 and 26), 16 (lines 18 and 19), 17 (lines 16 and 17); and 19 (lines 18 and 19) are ambiguous because it is unclear what 'activated ester' and 'anhydride' compounds Applicant is referring to which are compatible with the instant invention.

Claims 11, 14, 16, 17, 19, 21, 22, and 65: The claims as written are ambiguous because of the phrase 'capable of' that appears throughout the claims. In particular, the recitation that an element is capable of performing some function is not a positive recitation, but only requires that the element have the ability to so perform that function. As a result, throughout the method

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steps, it is unclear whether those steps are actually performed or not since the phrase contradict some of the other steps in the claims. For example, in claim 11, it is disclosed that the carboxylate precursor groups are 'capable of being transform into carboxylate moieties'. Step (e) in claim 11 requires that the transformed carboxylate moieties be utilized. Hence, it is unclear whether the carboxylate precursors are transformed into carboxylate moieties or not. Please clarify in order that one may readily ascertain what is being claimed.

COMMENTS/NOTES

5. It should be noted that no prior art has been cited against the instant invention. The claims are distinguished over the prior art of record for reasons of record in the office action mailed 2/9/06.
6. Due to the complexity of some of the 112, second paragraph, issues, Applicant was not called for the claims.
7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. L. Jones
Primary Examiner
Art Unit 1618

September 5, 2006